

REMARKS

Claims 9 to 16 are currently pending.

Applicants thank the Examiner for acknowledging the claim for foreign priority and indicating that all certified copies of the priority documents have been received.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, PTO 1449 paper and cited references.

Claims 9 to 16 were rejected under 35 U.S.C. § 103(a) as unpatentable over EP 1239370 to "Otterbach" in view of EP 0995646 to "Griessbach."

To reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the "problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem", Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998).

In particular, in rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

The combination of Otterbach and Griessbach (the properness of which is not conceded) does not disclose or suggest the feature of "an interface for receiving a software element which is configured such that as a function of the software element all firing circuits, and a triggering algorithm for firing all the firing circuits, are configured, and sensor values for the safety module are emulated such that the safety module **enables all the firing**

circuits", as provided for in the context of claim 9. The Otterbach reference refers to a method of checking an interface module by sending stored values representing sensor values to a safety module. The safety module then checks its functioning with the stored values. The stored values referred to in Otterbach **do not** enable all the firing circuits as the interface module is placed into a test mode when the testing begins. Thus, claim 9 is allowable.

Claims 10 to 16 depend from claim 9, and therefore are allowable for at least the same reasons as claim 9.

In summary, claims 9 to 16 are allowable.

CONCLUSION

In view of the foregoing, all pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

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